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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,850	10/31/2003	Andrew Robert Byde	B-5282 621413-6	9319

7590 04/30/2008
HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

NELSON, FREDA ANN

ART UNIT	PAPER NUMBER
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3628

MAIL DATE	DELIVERY MODE
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04/30/2008 PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/698,850	BYDE ET AL.	
	Examiner	Art Unit	
	FREDA A. NELSON	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 08 February 2008.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-12, 14-25, 27 and 28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-12, 14-25, and 27-28 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

The amendment received on February 8, 2008 is acknowledged and entered.

Claims 1, 3, 9, 14, 22, and 27 have been amended. Claims 13 and 26 have been canceled. Claims 2, 4-8, 10-13, 15-21, 23-26, and 28 are currently pending.

Response to Amendment and Arguments

Applicant's arguments, see REMARKS/ARGUMENTS, page 12, filed February 8, 2008, with respect to the rejection(s) of claim(s) 1-11, 14-17, 19, 21-23, and 27-28 under 35 U.S.C. 102(e) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Jacobus et al. (US PG Pub. 2004/0068454).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 1-3, 14-16, and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claims 1-2, 14-15, and 27, the examiner is unable to determine by the claim language “good or service may be purchased”, if the goods or services are actually purchased or just capable of being purchased. Because the applicant has not positively recited that goods or service are purchased, the examiner takes the alternative position that the goods or services are not actually purchased.

As per claims 1, 14, and 27, the examiner is unable to determine what the applicant is claiming by the claim language, “determining, estimating or otherwise obtaining one or more outcomes”. Because the applicant has not positively recited a “means and method for performing **one of the acts** from the group of determining, estimating, and obtaining one or outcomes for each of the purchasing times”, the Examiner interprets the claim language to mean that the apparatus and method of the instant invention comprises the means and method for performing **one of the acts** from the group of determining, estimating, and obtaining one or outcomes for each of the purchasing times.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to

be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-11, 14-17, 19, 21-23, and 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ganesan et al. (US PG Pub. 2004/0153376), in view of Jacobus et al. (US PG Pub. 2004/0068454).

As per claims 1, 14, and 27, Ganesan et al. disclose an apparatus for use in making a purchase decision regarding purchase of a plurality of units of a good or service from a plurality of potential suppliers at a plurality of purchasing times within a purchase period, the apparatus comprising means for determining, estimating or otherwise obtaining one or more outcomes for each of said purchasing times, each outcome being defined in terms of a quantity of units of said good or service to be purchased at a respective purchasing time (paragraphs [0005],[0062],[0074]),

means for accessing details of terms under which said good or service may be purchased from each of said potential suppliers during said purchase period (paragraph [0013]), and

means for determining an optimal purchase strategy regarding purchase of said good or service during said purchase period, said optimal purchase strategy being defined in terms of, for each outcome, an allocation among said plurality of potential suppliers of a quantity of said good or service to be purchased upon an occurrence in the event of said outcome, so as to minimise a total predicted cost of purchasing said good or service during said purchase period (paragraphs [0014]-[0015],[0024]).

Ganesan et al. does not explicitly disclose each outcome being defined in terms of a predicted price of said good or service at a respective purchasing time.

However, Jacobus et al. disclose based on forecasted demand levels, as well as price and availability forecasts, production planners may evaluate and manage the risks associated with various component procurement strategies to obtain an optimal sourcing mix for one or more of the component parts that are needed to manufacture the products sold to end customers 12 (paragraph [0051]; FIG. 2 and 4); and referring to FIG. 4, in response to a selection of the Forecast Inputs button, graphical user interface 42 displays a Component Demand Forecast window, a Component Price Forecast window, a Component Availability Forecast window, and an Advanced Settings: Forecast Scenario Correlation window; wherein the Component Demand Forecast window contains information relating to high, base and low demand forecast scenarios over time; and the Component Price Forecast window contains information relating to high, base and low price forecast scenarios over time. Jacobus et al. still further discloses a user may use procurement risk management system 40 to determine whether to purchase inventory at an offered price that is below the current market price and how much inventory to buy as follows. Among the factors that would influence the inventory buy decision are future market prices (e.g., future market prices could be cheaper than the offered inventory buy price) and future demand (e.g., the inventory buy quantity could be too high if demand falls, resulting in excess inventories and inventory write-downs)(paragraph [0303]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Ganesan et al. to include the feature of Jacobus et al. in or to provide forecasted scenarios for resource demand, resource price, and resource availability in aid in buy decisions.

As per claims 2, 15, and 28, Ganesan et al. disclose an apparatus wherein said terms under which said good or service may be purchased from each of the potential suppliers during said purchase period include any discount offered if a quantity of units of the good or service purchase exceeds a predetermined level (paragraphs [0048],[0051]).

As per claims 3 and 16, Ganesan et al. disclose an apparatus, wherein said terms include any penalty which may be incurred if a quantity of units of the good or service purchased during said purchase period is less than a preset minimum (paragraphs [0048],[0051]).

As per claims 4 and 17, Ganesan et al. disclose an apparatus, wherein a total quantity of units of said good or service expected to be required to be purchased at one or more purchasing times within said purchase period is estimated by means of a probability function (paragraphs [0022]-[0035]; FIG. 2).

As per claims 5 and 7, Ganesan et al. does not disclose an apparatus wherein probability function is based on one or more quantities of the good or service purchased at respective previous purchasing times; and wherein said probability function is based on one or more prices or price variations at respective previous purchasing times, however claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959). A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). Thus the structural limitations of claims 5 and 7, are disclosed in Ganesan et al. as described herein. Ganesan et al. discloses a system that generates an optimized supplier allocation plan ([0007], [0010], FIG. 1). Also as described the limitations of the claim do not distinguish the claimed apparatus from the prior art.

As per claims 6 and 19, Ganesan et al. disclose an apparatus, wherein predicted price fluctuations of said good or service are estimated by means of a probability function (paragraphs [0038],[0051]).

As per claims 8 and 21, Ganesan et al. disclose and apparatus arranged to calculate a minimum expected cost of future purchasing of the good or service within said purchase period (paragraph [0053]).

As per claims 9 and 22, Ganesan et al. disclose an apparatus, wherein an expected cost of the good or service is calculated by calculating an expected cost of purchasing in respect of each outcome relating to the or each purchasing time within said period utilizing the predicted price of the good or service as well the quantity of the good or service to be purchased for each said outcome ([0013],[0051]).

As per claims 10 and 23, Ganesan et al. disclose an apparatus, wherein said minimum expected purchasing cost is calculated taking into account discounts offered by one or more suppliers for single orders of the good or service consisting of a quantity of units greater than a predetermined level, discounts offered by one or more of the suppliers for cumulative orders of the good or service greater than a predetermined level, and penalties applied by one or more of the suppliers in the event that the quantity of the good or service purchased during a contract period is less than a pre-set minimum (paragraphs [0013], [0048], [0051]).

As per claims 11-12, Ganesan et al does not expressly disclose an apparatus, wherein said minimum expected purchasing cost is calculated taking

into account shipping costs in respect of each potential supplier; and wherein said shipping costs are modelled as a constant per unit of said good or service.

However, it is old and well known in the business art to include shipping/and or delivery costs when making procurement decisions.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Ganesan et al. to include the feature of including shipping costs when considering procuring goods or services from a potential supplier in order to get a more accurate purchasing cost.

As per claims 18 and 20, Ganesan et al. does not disclose an apparatus wherein probability function is based on one or more quantities of the good or service purchased at respective previous purchasing times; and wherein said probability function is based on one or more prices or price variations at respective previous purchasing times, however, information as to the probability function being based on one or more quantities of the good or service purchased at respective previous purchasing times; and wherein said probability function is based on one or more prices or price variations at respective previous purchasing times is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See : *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembicza* 175 F.3d 994, 1000, 50

USPQ2d 1614, 1618 (Fed. Cir. 1999). The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter how the process steps are to be performed. The method steps, disclosed would be performed the same probability function. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a probability function for the optimization for purchasing goods or services because the basis for the probability function does not functionally relate to the steps in the method claimed.

As per claims 24-25, Ganesan et al does not expressly disclose a method, wherein said minimum expected purchasing cost is calculated taking into account shipping costs in respect of each potential supplier; and wherein said shipping costs are modelled as a constant per unit of said good or service.

However, it is old and well known in the business art to include shipping/and or delivery costs when making procurement decisions.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Ganesan et al. to include the feature of including shipping costs when considering procuring goods or services from a potential supplier in order to get a more accurate purchasing cost.

Conclusion

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Freda A. Nelson whose telephone number is (571) 272-7076. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/F. A. N./
Examiner, Art Unit 3628
04/28/2008

/JOHN W HAYES/
Supervisory Patent Examiner, Art Unit 3628